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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application. of:	)	Attorney Docket No. 5634.140
	)	
HARVEY <i>et al.</i>	)	Confirmation No. 8574
	)	
Serial No.: 08/447,447	)	TC/A.U.: 2616
	)	Examiner: Andrew I. Faile
Filed: May 23, 1995	)	
	)	Customer No. 21967

For: SIGNAL PROCESSING APPARATUS AND METHODS

PETITION TO REVIEW DECISION OF TECHNOLOGY CENTER DIRECTOR  
UNDER 37 C.F.R. § 1.181

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This petition is a request that the Director of Patents and Trademarks ("Director") (1) review the Decision on Petition signed by Andrew Faile, Director, Technology Center 2600, Communications, mailed August 31, 2005 ("Decision"), and (2) exercise his supervisory authority to reverse the Decision of the TC Director, to require any suspension of this application be lifted and to order the Examiner to take up this application for prompt examination. On January 6, 2005, the Office issued a letter suspending action in this application at the initiation of the Office ("Suspension Letter"). On March 7, 2005, applicants filed a petition in response to the suspension of action ("Initial Petition"). The Decision is responsive to the Initial Petition.

The prosecution history of this application is set forth in the Initial Petition, hereby incorporated by reference. In short, this application has been pending for over ten years. Applicants filed a response to the last Office Action on March 5, 2003, over 31 months ago. No further action has been received from the Office in this application. Rather almost two years after filing the response, on January 6, 2005, the Office suspended action in this application for six months. Although, this official suspension expired in July, no further action has been forthcoming from the Office. Rather, a continuing *de facto* suspension of this application and numerous other of applicants' related applications appears to be in place. There is no justification for the Office's refusal to examine this application.

This application was filed May 23, 1995. The claims pending in this application have an effective U.S. filing date of September 11, 1987. "Each examiner will give priority to that application on his or docket which has the *oldest effective U.S. filing date*." M.P.E.P. § 708 (8<sup>th</sup> Ed. Rev. 2, 2004). Applicant has at least 27 other similarly situated applications based on the same specification that have been pending over ten years and have an effective U.S. filing date of at least September 11, 1987. The Office has not given these applications the attention they are due based on their priority date.

As noted above, applicants filed a response to the last Office Action on March 5, 2003. The Examiner did not give priority to this application. Rather, 22 months later the Office suspended action in this application. The Suspension Letters were also mailed in applicants' related applications. The suspension of action is especially egregious because the Office indicates that suspension is due to the fact that instant application has a specification that is

identical to one or more patents that are currently under reexamination. The Office asserts that it is appropriate to suspend prosecution, as the final determinations in the reexamination proceedings are likely to affect the outcome of this application. The Office has not suspended prosecution of two of applicants' pending applications that are under appeal. The Office further asserts that the outcome of these appeals is also likely to affect the outcome of this application. Thus, the Office not only is not giving priority to applicants' applications that have been pending over ten years, but the Office appears to propose to examine the applications in a sequential fashion, *i.e.* addressing issues that arise in one proceeding at a time. The Office provides no justification for proceeding in this manner. This delay in examination is outrageous and contrary to the established procedures of the Office.

#### **Petition to Require Prompt Examination**

Applicants respectfully petition the Director under 37 C.F.R. § 1.181(a)(3) to invoke his supervisory authority to overturn the Decision and require the prompt examination of the instant application. In the Decision, the Technology Center Director ("TC Director") acknowledges that this application is considered special under M.P.E.P. § 708.01(i) due to the pendency exceeding five years. Decision p. 4. The suspended status of this and applicants related application is contrary to the special status of the applications.

Applicants note that the Suspension Letter sets forth a suspension of action for six months from January 6, 2005, *i.e.* until July 6, 2005. The Decision was not issued until after the stated suspension period expired. Yet the TC Director asserts in the Decision that this application remains suspended. Decision p. 4. In an utterly hollow statement, the TC Director

pledges: “Subsequent to the suspension being lifted, the application will be taken out of turn and afforded expedited examination.” *Id.* It thus appears that the Office considers this application, and applicants’ similarly situated applications, to be suspended indefinitely. There is no authority for the Office to indefinitely suspend action on a patent application. Such indefinite suspension is contrary to the special status of this application and contrary to the law, the Office rules as set forth at Title 37 of the Code of Federal Regulations and the Office procedure as set forth in the M.P.E.P.

Title 35 U.S.C. § 132(a) states that if after receiving an Office action, “the applicant persists in his claim for a patent, . . . the application *shall* be reexamined.” (Emphasis added.) The regulations promulgated by the Office likewise indicate that the applicant is entitled reconsideration or further examination upon filing a reply that complies with the requirements set forth in 37 C.F.R. § 1.111. The Office may not shirk its duty to reconsider this application through an indefinite suspension of action. The Office procedures set forth at M.P.E.P. § 707.02 state: “Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution.” The indefinite suspension of action in this application is the antithesis of the effort required of the Office to terminate prosecution. The suspension of action in this application is contrary to the duty of the Office to examine this application.

The Office’s guidelines regarding suspension of action at the initiative of the Office are set forth at M.P.E.P. § 709 II. These guidelines have been utterly disregarded. “Suspension of action at the initiative of the Office should be avoided, if possible, because such suspension will

cause delays in examination [and] will increase pendency of the application.” M.P.E.P. § 709 II. The Office has done nothing to avoid delay or avoid an increase in the pendency of this application. Furthermore, this is not the first suspension of action of this application. *See* Letter of Suspension mailed July 22, 1997. “If, in extraordinary circumstance, a second or subsequent suspension is necessary, the examiner must obtain the TC director’s approval (see MPEP § 1003) and prepare another suspension notification with a suspension period (a maximum of 6 months).” M.P.E.P. § 709 II. There is no extraordinary circumstance warranting suspension of action in this application. “A notification of suspension must be mailed to the applicant for each Office-initiated suspension of action, even for second or subsequent suspensions, and must include a suspension period (a maximum of 6 months). When the suspension period has expired, the examiner should take up action on the application or evaluate all possibilities for giving an action on the merits.” *Id.* The suspension period should have expired in July 2005. The Examiner has not issued an action upon taking up the application for action upon expiration of the suspension period. To the contrary, the TC Director in the Decision indicates that the application remains suspended for good and sufficient cause. Such an indefinite suspension is contrary to the guidelines of the M.P.E.P., which set forth that the maximum suspension period is six months.

Suspension at the initiative of the Office should be avoided. Accordingly, action should only be suspended where examination cannot proceed. The M.P.E.P. identifies only two situations where examination cannot proceed: 1) where a reference relevant to the examination is not yet available, and 2) where all claims are allowable, but there is a possible interference. M.P.E.P. § 709 II. The M.P.E.P. makes clear that these are narrow circumstances. In the case of

an unavailable reference, the Examiner should find another source for the information or find another reference to make the rejection if the reference does not become available. *Id.* An indefinite suspension is inappropriate. Similarly, in the case of a possible interference, examination is fully conducted until the claims are found to be allowable. It is only at this point that action is suspended. *Id.* There is no analogous reason that the examination of the instant application cannot be conducted at this time.

The Suspension Letter asserts the following.

The instant application has a specification that is identical to one or more patents that are currently under reexamination. The issues present in the reexamination proceedings are related to the issues in the instant application. The final decisions/determinations made at the end of the reexamination proceedings are likely to affect the outcome of this application. To this end, it is appropriate to suspend prosecution on the instant application.

Per applicant's request, however, prosecution in 08/470,571 (INTE) and 08/487,526 (MULT) will not be suspended in order to pursue the issues that have been fully developed in these applications. The outcome of these issues is also likely to affect the outcome of the present application.

The Decision at page 3 likewise asserts:

Contrary to petitioner's arguments, the outcome of the related reexamination proceedings have a direct bearing on the prosecution of this and the related applications under suspension. Petitioner argues that the claims of the reexamination proceedings are different than the instant claims. However, the specifications are the same and the claims so closely related as to warrant disposition of the reexamination proceedings prior to continuing the prosecution in the instant case. The related pending applications that currently are under appeal have prosecution that is closely related to this and other suspended files. The decision soon to be rendered by the Board of Patent Appeals and Interferences will have a material impact in determining future

action by the Office as whether to allow or reject certain claims. A decision by the Board is necessary as a form of guidance to steer prosecution of the remaining cases in a manner commensurate with the Board's decision. Having this information prior to continuing prosecution of the remaining cases will afford both applicants and the Office information vital in order to focus prosecution, undoubtedly significant prosecution time and resources for both parties.

The above assertions do not approach a sufficient basis for the Office to suspend its duty to examine this application.

The Office's arguments support the proposition that examination of any pending application may be suspended anytime reexamination is granted on a patent that shares a common specification. Applicants find no authority endorsing suspension of related applications when the Office grants a reexamination request. Similarly, the Office's arguments apply anytime an applicant appeals an examiner's decision when copending applications share a specification. Applicants find no authority that permits the Office to force an applicant to choose between pursuing an appeal in certain applications or continue prosecution before the examiner in other applications. The Office has a duty to advance the examination of applicants' special applications. The initiation of reexamination proceedings and appeals in copending application does not abrogate the duty of the Office.

The suspensions inappropriately make the examination of this application contingent on the reexamination of applicants' issued patents and the examination of the INTE and MULT applications. Such contingent examination ensures that any delays in the reexamination or appeals of the INTE or MULT applications, will delay the prosecution of all of applicants'

suspended applications. Concern regarding such delay is not unwarranted. Despite the fact that reexamination proceedings must be conducted with special dispatch (35 U.S.C. § 305), no action has been received in the reexamination of applicants' Patent No. 5,109,414, which was ordered on January 8, 2004. As there is no indication that the Office is actually conducting the reexamination of the '414 patent, the suspension of action pending the final determination of the reexamination proceedings appears to be truly indefinite. Likewise, applicant submitted appeal briefs in the INTE and MULT applications on February 6, 2005, and March 7, 2005, respectively. Although the Decision refers to the decision *soon* to be rendered by the Board, the Examiner's Answer in the INTE application was only recently received after applicants 1) petitioned the Director to order the Examiner to take up the appeal briefs and issue an Examiner's answer and 2) wrote to the Deputy Commissioner for Patents regarding the delay. Despite these actions by applicants, no Examiner's Answer in the MULT application has been issued. The Office should not be permitted to structure the examination of applicants' pending applications in such a manner that unreasonable delay in the reexamination proceedings and the INTE and MULT appeals necessarily delays the prosecution of all of applicants' other applications.

The TC Director has identified no issues to be resolved in the instant application that are addressed in reexamination proceedings or in the INTE or MULT appeals. The TC Director asserts "the specifications are the same and the claims so closely related as to warrant disposition of the reexamination proceedings prior to continuing the prosecution in the instant case." There is no support for this assertion. In the last Office action mailed September 5, 2002, the claims of



the instant application were only rejected under 35 U.S.C. § 112. However, determinations of patentability under 35 U.S.C. § 112 are not subject to reexamination. “Issues relating to 35 U.S.C. 112 are addressed [during reexamination] only with respect to new claims or amendatory subject matter in the specification, claims or drawings.” M.P.E.P. § 2258. During the reexamination proceedings, no new claims have been added, the common specification and drawings are not amended, and only one claim is amended. There is no indication that prosecution of the single amended claim in the reexamination proceedings will raise any issues necessary to bring the instant application to a final disposition. Likewise, the TC Director identifies no issues to be decided in the INTE or MULT appeals that are applicable to the instant application. The TC Director erroneously states: “A decision by the Board is necessary as a form of guidance to steer prosecution of the remaining cases in a manner commensurate with the Board’s decision.” The TC Director identifies no decision by the Board that is necessary to conduct the examination of the instant application.<sup>1</sup>

There is no reason that examination of applications and reexamination of patents that share a common specification should not proceed concurrently. Any common issues that arise in different proceedings may be treated identically by the Office and resolved more expediently

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<sup>1</sup> The Office has asserted in various of applicants’ pending applications that applicants’ chain of priority application common to all of the pending applications is insufficient to support any claim of priority to applicants’ original November 3, 1981, filing date. The Office agreed not to suspend action in the INTE and MULT applications to address this issue. However, applicant has not relied on the 1981 priority date to overcome any rejection in the instant application. Furthermore, in the final Office action in the INTE application the Examiner withdrew all intervening art. Accordingly, the 1981 priority date is not at issue in the INTE appeal.

during concurrent prosecution that by sequential prosecution. The Office may take consistent positions in multiple examinations that proceed concurrently. The Examiners may use concurrent proceeding to identify common issues among applications. Concurrent prosecution will also allow applications in which common issues do not arise to reach final disposition. It is unreasonable to suspend prosecution in an application that may have allowable claims. This is the situation of the instant application. The only rejections are under 35 U.S.C. § 112. The last response demonstrates how the specification supports the language of the claims in the instant application. The TC Director points to no issue to be resolved in any of the reexamination proceedings or the INTE or MULT appeals that are necessary to determining whether the support provided in the last response demonstrates that the claims comply with the requirements of Section 112. Accordingly, there is no justification to delay the reconsideration of these claims pending the outcome of the reexamination proceedings or pending the outcome of the appeals of the INTE or MULT applications.

The Office's suspension of action in this application based on the fact that many of the issued patents under reexamination, the INTE and MULT applications, and the instant application share a common specification is arbitrary and capricious. It is common practice for multiple applications sharing a common parent specification to be examined concurrently in the Office. For example, after a restriction requirement identifying several claimed inventions is made during prosecution, an applicant will frequently file several divisional applications with identical specifications. *See* M.P.E.P. § 803. The Office then examines these applications sharing a common specification concurrently. There is no Office policy to suspend prosecution

of all but one or two applications sharing a common specification to settle potential issues that may arise due to the common history of the applications. Accordingly, the Office's action to suspend applicants' application is arbitrary and capricious.

Applicant respectfully requests under 37 C.F.R. §1.181(a)(3) that the Director exercise his supervisory authority to reverse the Decision of the TC Director, to require any suspension of this application be lifted and to order the Examiner to take up this application for prompt examination.

#### **Request for Reconsideration of Decision**

Applicants request that the Decision on Petition mailed August 31, 2005 be reconsidered. As no action has been received in this application, applicants renew the requests made in the Initial Petition, incorporated by reference herein.

Applicants request that the Decision regarding the Decision on the following requests to be reconsidered.

1. Require the Examiner to rescind the Notices of Suspension.
2. Impose a schedule for the prompt examination of this application and the Related Applications.
3. Declare that this application and the Related Application are "special", and treat them as such.
4. Assign new and objective primary Examiners to this and the Related Applications.
5. Establish a committee to supervise the examination of this and the Related Applications to ensure that the examination is conducted in accordance with an accelerated schedule.

#### **Rescinding Notice of Suspension**

The Petition to rescind the suspension was denied in the Decision. Applicants request that this denial be reconsidered. Although the stated term of the suspension has expired, the

Office continues to treat this application as suspended. The Notice of Suspension asserts: "The final decisions/determinations made at the end of the reexamination proceedings are likely to affect the outcome of the application." The Notice of Suspension also asserts that the outcome of issues developed in the INTE and MULT applications under appeal is also likely to affect the outcome the present application. Accordingly, it appears that the Office does not intend to act on this application and applicants' related application until all of the reexamination proceedings are concluded and the appeals in the INTE and MULT application have been decided. It is unlikely that these determinations will be made within the next six-months. Rather, it appears that the Office intends to keep this application and applicants' related application suspended for years. Sequential prosecution of all of applicants' related applications could take decades at the current pace of examination.

Applicants request that the decision to deny the Petition to rescind the suspension be reconsidered. The reasons provided in the Decision fail to provide justification for taking the extraordinary action of suspending this and applicants' related applications. As noted above, it appears that the Office intends to keep this application suspended pending the outcome of the reexamination proceedings against applicants' issued patents and pending the outcome of the appeals in the INTE and MULT application. There is no justification for such an extraordinary action by the Office.

With regard to the reexamination proceedings, in the Decision, the TC Director argues: "the specifications are the same and the claims so closely related as to warrant disposition of the reexamination proceeding prior to continuing the prosecution in the instant case." There is no

support for this argument. That pending application share a specification with a patent under reexamination does not warrant suspending action in the pending application regardless of how closely related the claims may be. The Office is under a duty to examine this and applicants' related applications as set forth in the Initial Petition. That the Office is conducting a related proceeding does not justify the Office suspending its duty to examine applicants' applications. The Decision provides no reasoning why identical specifications and closely related claims between patents under reexamination and pending applications warrant suspension of action in the pending applications.

With regard to the appeals in the INTE and MULT applications, the Decision states: "The decision soon to be rendered by the Board of Patent of Appeals and Interferences will have a material impact in determining future action by the Office as whether to allow or reject certain claims." The Decision identifies not one issue to be resolved by the INTE or MULT appeals, the resolution of which is necessary for the allowance of this application. The Decision fails to explain how a decision in the pending appeals will have a material impact on the rejections in this application.

The Decision states: "A decision by the Board is necessary as a form of guidance to steer prosecution of the remaining cases in a manner commensurate with the Board's decision." This statement is false. A decision by the Board is not necessary to continue prosecution of this and the related applications. Any relevant position asserted by the Examiner in the applications under appeal may also be asserted by the Examiner in this application (should there be any overlapping relevant issues in dispute). Should the Board reverse any position taken by the

Examiner, the Examiner may then withdraw any rejection based on such a position. It is simply not necessary to suspend this application pending the resolution of the appeals in the related applications.

The Decision somewhat confusingly states: "Having [a decision by the Board in the related appeals] prior to continuing prosecution of the remaining cases will afford both applicant and the Office information vital in order to focus prosecution, undoubtedly significant prosecution time and resources for both parties." It appears that the TC Director is asserting in the Decision that it will be more efficient to suspend prosecution of applicants' applications pending the decision on the appeals of the related applications. First, efficiency is not a sufficient justification for the Office to suspend its duty. Second, suspension is not efficient.

The suspension of this and applicants' related application serves merely to delay final disposition of these applications. Such delay is not efficient. The Office has identified no issue in this application that is addressed in the appeals of the related applications. However, there are many issues (based on different claim terms and different applied art) pending in this and the related suspended applications that are not addressed by the INTE and MULT appeals. Efficiency demands that these issues be identified and resolved concurrently with the issues raised in the INTE and MULT appeals. In other words, the Office should at least continue prosecution of this and applicants' related application until all issues not addressed by the pending appeals are resolved. Reconsideration may reveal no issue raised in the INTE or MULT appeals necessary to bring this application to a final disposition. In such a circumstance, this application may be issued or withdrawn without the Board's decision in the pending appeals.

The Decision provides no substantive justification for the denial of applicants' petition to require the Examiner to rescind the Notice of Suspension.

Impose a Schedule for Examination

Applicants request that the Director impose a schedule for the prompt examination of this application and the related applications was dismissed. Applicants request that this dismal be reconsidered. The TC Director asserts:

All applications filed in the PTO have an aggressive schedule for examination. MPEP § 708 states in part that "(e)ach examiner will give priority to that application in his or her docket, whether amended or new, which has the oldest effective U.S. filing date. Except as rare circumstances may justify Technology Center Directors in granting individual exceptions, this basic policy applies to all applications."

Decision, pp. 3-4 (emphasis in original). This statement is belied by the fact that this application and the related applications have been pending for over ten years with an effective U.S. filing date of at least September 11, 1987. It clear that the examiners assigned applicants' applications have not adhered to the procedures constituting the aggressive schedule noted by the TC Director. Nor have supervisory patent examiners adhered to the procedures of the Office. "Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution." M.P.E.P. § 707.02. The Office, to the contrary, is making no effort whatsoever to terminate the prosecution of this application. The Office procedures as set forth in the M.P.E.P. are not applied to applicants' application because the TC Director has determined: "The situation in this case and in the related pending cases as pointed out by petitioner and addressed herein clearly is a rare justifiable

circumstance warranting exception by the Technology Center Director to suspend the instant application.” Decision p. 4. Applicants have pointed out this is a rare circumstance because the application has been pending for over ten years. Such circumstance does not justify further delay through suspension of action. The Office erroneously asserts that the circumstances are rare because the Office is considering related claims based on identical specifications in other proceedings. However, this is not a rare circumstance that justifies suspension as discussed above. As this application has been pending for over ten years, the Office rules mandate that it be reconsidered immediately by the Examiner. In spite of this mandate, the Examiner, the supervisory patent examiner, and TC Director each condone taking no action on this application whatsoever. Accordingly, imposition of a schedule requiring prompt examination of this application is required. The TC Director asserts: “Since the application is in a suspended status, an ‘aggressive’ schedule cannot be contemplated at this time.” Applicants assert that since an aggressive schedule of examination is warranted, the suspended status is inappropriate.

#### Application Granted “Special” Status

Applicants’ request that the Director declare this application and applicants’ related applications special and treat them as such was dismissed. Applicants request that this dismal be reconsidered. In the Decision, it is acknowledged that this application must be considered special because its pendency is in excess of five years. However, applicants’ request was dismissed on the grounds that a petition to effect such special status is unnecessary. Applicants disagree. The Decision’s assertion that the M.P.E.P. indicates that this application is special in nature is insufficient. There is no evidence that the Office treats this application as special.



Accordingly, applicants assert that a formal declaration that this application and applicants' related applications are special is warranted. Applicants requested that the examiners be required to actually treat this application and applicants' related application as special. The Decision is silent on this request.

Assign New and Objective Primary Examiner

Applicants' request that the Director assign new and objective primary Examiners to this and the related applications was dismissed. Applicants request that this dismissal be reconsidered.

Applicants assert that new and objective examiners are required for a prompt examination of this application for the reasons set forth in the March Petition. The TC Director asserts:

Applicant has no right to pick and choose the examiner assigned to a particular application as this would cause undue burden upon the agency. Applicant has two avenues of relief when disagreeing with the examiner. 1) The remedy for improper rejection is appeal to the BPAI (37 CFR 1.191(a)) and 2.) The remedy for other improper examiner actions is petition (37 CFR 1.181(a)).

Decision, p. 4. The TC Director conveniently fails to set forth an avenue of relief when the Office refuses to act. Applicants do not request the ability to pick and choose the examiner assigned to a particular application. Rather Applicants simply request that an examiner be assigned to the application who will conduct a proper, prompt examination. The Examiners previously assigned to this application have not conducted such a proper, prompt examination.

The TC Director asserts that this request is moot and therefore dismissed. If the Office has not granted applicants' request, then the request is not moot. Accordingly, applicants assert that the dismissal is improper.

Establish a Committee to Supervise the Examination

Applicants' request to establish a committee to supervise the examination of this and the related applications to ensure that the examination is conducted in accordance with an accelerated schedule was denied. Applicants request reconsideration of this denial. The TC Director asserted: "Examination by committee is not the 'normal' practice of examination by the agency." However, this application is in the extraordinary position of being pending before the Office for over ten years. The "normal" practice of examination by the agency has been revealed ineffective. Applicants assert that these extraordinary circumstances warrant special procedures to ensure that this application is advanced to final disposition without undue delay. Applicants do not propose examination by committee. Rather, applicants propose that the Director establish sufficient oversight over the Examiner to ensure prompt examination of this and applicants' related applications. As set forth in the Initial Petition, such action is required because the current supervision has not produced an examination in accordance with the established procedures of the Office.

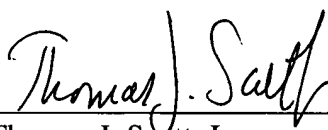
## Conclusion

The Office is not fulfilling its duty to examine this application and applicants' related applications that have been pending for over ten years. To the contrary, the Office has suspended the examination of this and most of applicants' related applications. The Office has provided no reasonable justification for delaying the reconsideration of this application. Accordingly, further delay in the prosecution of this application can only be considered to be arbitrary and capricious. Applicants request reconsideration of the March 7, 2005, Petition filed in response to the Notice of Suspension in this application. Applicants further petition the Director under 37 C.F.R. §1.181(a)(3) to request that the Director exercise his supervisory authority to reverse the Decision of the TC Director, to require any suspension of this application be lifted and to order the Examiner to take up this application for prompt examination.

Respectfully submitted,

HUNTON & WILLIAMS LLP

By:

  
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Dated: October 26, 2005

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